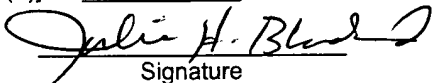


# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Attorney Docket No.  
**VIGN1410**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as EXPRESS MAIL [Label No. EV679279634US] in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on 12-15, 2006

  
Signature

JULIE H. BRACKARD  
Typed or Printed Name

Application No.  
**09/989,814**

Filed:  
**11/20/2001**

First Named Inventor:  
**Robin D. Wilson**

Art Unit  
**2178**

Examiner  
**PAULA, Cesar B.**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor
- ☐ Assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ Attorney or agent of record.  
Registration No. 51,388
- ☐ Attorney or agent acting under 37 CFR 1.34  
Registration No. \_\_\_\_\_

  
Signature

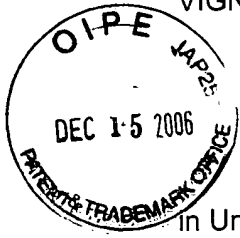
Ari G. Akmal  
Typed or Printed Name

512-637-9220  
Telephone Number

12-15-06  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. See below\*.

☒ \*Total of 1 form is submitted.



**Remarks**

In an Office Action dated September 15, 2006 (the "September 15 Office Action") in United States Patent Application No. 09/989,814 (the "Current Application"), the Examiner rejected Claims 17-19 under 35 U.S.C. § 112 as lacking enablement, Claims 1-8 under 35 U.S.C. § 103(a) as being obvious over MyYahoo.com Help Pages, Archive.org ("Yahoo") in view of United States Patent No. 5,983,227 issued to Nazem ("Nazem") and Claims 17-19 and 21-29 under 35 U.S.C. § 103(a) as being obvious over Yahoo in view of United States Publication No. 2002/00781040 issued to Kelly et al ("Kelly").

**Rejection Under 35 U.S.C. § 112**

The Examiner has rejected Claims 17-19 under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement. More particularly, the Examiner cites the limitation of Claim 17 which recites "disabling the second object's ability to utilize the selected asset," stating that, "[i]t is still believed that the specification does not appear to describe this limitation in a way that enables one of ordinary skill in the art at the time of the invention to disable the ability to use the asset." See September 15 Office Action, Page 3, Lines 3-5.

Applicant notes that the fact that a claim limitation may lack descriptive support in the disclosure as originally filed does not necessarily mean that the limitation is also not enabled. Furthermore, when the subject matter is not in the specification portion of the application as filed but is in the claims, the limitation in and of itself may enable one skilled in the art to make and use the claim containing the limitation. See M.P.E.P. § 2164

In this case, however, the limitation which the Examiner claims is not enabled is specifically described in the Specification at paragraph [0045] which states that "[i]f the child site wishes to modify the asset, the modifications are made to a copy of the asset, which is then stored by the child site. The reference to the original asset is also retained by the child site, but it is disabled." Similar descriptions relating to this limitation can be found at many other places within the Specification of the Current Application, including at least in Paragraphs [0007], [0008], [0026], [0031], [0034], [0037] and [0052]. A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing

and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. See M.P.E.P. § 2164

Furthermore, in order to make a rejection under 35 U.S.C. § 112, first paragraph, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). As stated by the court in *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971) "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the Examiner to give reasons for the uncertainty of the enablement.

Here, the Examiner has offered no supporting evidence or reasonable explanation why he believes Claims 17-19 are not enabled by the specification of the Current Application, rejecting Claims 17-19 off-hand with the statement that he "believes that the specification does not appear to describe this limitation" in an enabling manner. See September 15 Office Action Page 3, Lines 3-5. Moreover, Applicant notes that Claims 17-19 are in a state substantially similar to their condition in the original filing of the Current Application, and that neither of the previous Office Actions issued on October 5, 2004 and May 18, 2005 contain a similar rejection of these claims under 35 U.S.C. § 112 first paragraph. In fact, in the May 18, 2005 Office Action these very claims (i.e. Claims 17-19) were deemed allowed by the very same Examiner who now believes that these claims are not enabled.

Applicant submits that the baseless and unsupported beliefs of the Examiner with respect to previously allowed Claims 17-19 are insufficient grounds for rejecting Claim 17-19 under 35 U.S.C. § 112 first, paragraph and that the Examiner is therefore incorrect in maintaining his rejection of Claims 17-19 under 35 U.S.C. § 112, first paragraph.

Rejection Under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-8 under 35 U.S.C. § 103(a) as being obvious over MyYahoo.com Help Pages, Archive.org ("Yahoo") in view of United States Patent No. 5,983,227 issued to Nazem ("Nazem") and Claims 17-19 and 21-29 under 35 U.S.C. § 103(a) as being obvious over Yahoo in view of United States Publication No. 2002/00781040 issued to Kelly et al ("Kelly").

Applicant submits that the rejections of Claims 1-8, 17-19 and 21-29 utilizing the Yahoo prior art are improper and, furthermore, the Yahoo art and the rejections which utilize this art are so nebulous as to preclude a fair opportunity for the Applicant to formulate a response to these rejections. In rejecting the claims of the Current Application using Yahoo the Examiner has simply cited screen captures from an Internet site, inferred non-disclosed functionality from these screen captures and then arbitrarily concluded that the way this inferred functionality is accomplished is equivalent to limitations of the claims.

Applicant notes, that "in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified," and that "it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." See 37 C.F.R. § 1.104, M.P.E.P. § 706

Here, the Examiner has not particularly designated the part of the Yahoo reference relied on for the disclosure of particular claim limitations. Additionally, the Examiner has inferred functionality not disclosed by the Yahoo art and concluded, without evidence, that this functionality is accomplished in the same manner as recited in limitations of the claims.

The Examiner's unsupported inferences and conclusions can be better illustrated with reference to particular claims and limitations. With reference to Claim 1 of the Current Application, the Examiner states that at pages 1-3 Yahoo discloses "a main website Yahoo.com having many personalized versions of the main websites [sic]—wherein one of the web sites is a parent and one of the web sites is a child of the parent." See September 15 Office Action, Page 3, Last Paragraph. Applicant cannot find where Yahoo discloses personalized version of a main website and, even if this

functionality were indeed disclosed, there is nothing in Yahoo to suggest that the websites are hierarchically related as parent and child. The Examiner has created from whole cloth both functionality, and how this functionality is accomplished, and attributed these to the Yahoo reference, as neither this functionality or how it is accomplished is disclosed in the Yahoo reference itself.

The Examiner's approach can be further illustrated with reference to other limitations of Claim 1. The Examiner states that pages 1-6 and 10-11 of the Yahoo reference teach that the main website contains assets which are shared with the personalized websites, a user can configure a version of the Yahoo website to incorporate content of the main website and there are certain assets that cannot be modified by the user. The Examiner goes on to state that this disclosure, in turn, is equivalent to the limitations of Claim 1 which recite "the parent having one or more assets and configured to share each of the assets using one of a set of modes consisting of a first mode in which both the first and second objects can utilize the asset, but only the first object can modify the asset and a second mode in which both the first and second objects can utilize the asset and both the first and second objects can modify the asset." See September 15 Office Action, Page 4 First and Second Paragraphs.

Applicant cannot find where Yahoo discloses that a main website shares assets, or that certain of these assets cannot be modified by a user. Even assuming Yahoo did disclose these things (which it does not), there is nothing in the Yahoo art which would teach or suggest that this functionality is accomplished by a parent "configured to share each of the assets using one of a set of modes consisting of a first mode in which both the first and second objects can utilize the asset, but only the first object can modify the asset and a second mode in which both the first and second objects can utilize the asset and both the first and second objects can modify the asset," as recited by Claim 1.

Once again the Examiner has inferred functionality from Yahoo and assumed that this functionality is accomplished in a manner identical to that recited in a claim limitation, despite the fact that neither the functionality, nor how that functionality is accomplished, is disclosed in the cited portion of Yahoo.

The Examiner has also disregarded a limitation of Claim 1 entirely. Claim 1 recites "a third mode in which the first object can utilize and modify the asset but wherein the second object can utilize the asset until the second object attempts to modify the asset at which time a copy of the asset is generated and the second object can utilize

and modify the copy of the asset." The Examiner has neglected to cite any portion of Yahoo (or any other prior art) that discloses this limitation.

The Examiner's modus operandi with respect to the rejection of the remainder of the claims pending in the Current Application (Claims 2-8, 17-19 and 21-30) over Yahoo is similar: the Examiner cites a large portion of Yahoo which he asserts discloses certain functionality and the Examiner then assumes that this asserted functionality is accomplished in a manner that corresponds to a claim limitation.

Consequently, Applicant asserts that the Examiner's rejection of Claims 1-8, 17-19 and 21-29 over the Yahoo art is improper for at least two reasons: first and foremost, the cited Yahoo art does not disclose the limitations which the Examiner asserts that it does and second, that both the Yahoo art and the nebulousness of the Examiner's citations and rejections using the Yahoo art have precluded the Applicant from having a fair chance to reply to the rejection of Claims 1-8, 17-19 and 21-29 under 35 U.S.C. § 103(a). Accordingly, Applicant submits that the Examiner is incorrect in maintaining the rejection of Claims 1-8, 17-19 and 21-29 under 35 U.S.C. § 103(a) over the Yahoo art.